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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,418	03/10/2004	James Louis DeRudder	122121-2	4129

7590

07/03/2006

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EXAMINER

BOYKIN, TERRESSA M

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/797,418	Applicant(s) DERUDDER ET AL.	
	Examiner Terressa M. Boykin	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-10-04; 11-23-05; 6-16-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/05; 6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5214183 col. 6 line s 61 through col. 7 line8, example 1 and table 1; or USP 5508375 see claim 1, or EP 06434220 see claim 1.

USP 5214183 discloses a process for making bisphenol monochloroformate polycarbonate oligomers is provided by continuously introducing phosgene into a bisphenol mixture under agitated interfacial conditions. The pH of the phosgenation mixture falls below a predetermined value, thereby effecting the introduction of an aqueous alkali hydroxide consistent with the use of particular base introduction control systems. In accordance with the use of such control systems, the pH of the mixture can be stabilized, and the phosgenation and base introduction terminated when the pH of the mixture suddenly dips at least about 1 pH unit, or a sudden increase in the flow rate of aqueous alkali metal hydroxide is noted after a plateau in the rate of base introduction. Note in tables 1 and 2 and example 2 that an aromatic bischloroformate mixture is produced.

The overall monochloroformate oligomer mixture comprises bischloroformate oligomers (both ends chloroformate), monochloroformate oligomers (one hydroxyl end and one chloroformate end), and bishydroxy oligomers (both ends hydroxyl). The

relative proportions of these oligomers in the bisphenol monochloroformate polycarbonate oligomer are substantially 1:2:1 for the bischloroformate, monochloroformate, and bishydroxyl.

EP 0644220 discloses a method for producing polycarbonates by the interfacial reaction of phosgene bisphenol in a two phase reaction medium of an aqueous hydroxide and an organic solvent is disclosed. In the reaction, the amount of water in the reaction medium is controlled such that high ionic strength conditions resulting from high salt concentrations are reached at the end of phosgenation and the pH of the medium is controlled to a range between 8 and 10 whereby excess phosgene usage is less than about 15% of theoretical conditions.

USP 5508375 relates to a process for the preparation of polycarbonates in which an oil-in-water emulsion is maintained throughout by employing special reaction conditions.

Each of the reference discloses an aromatic bishaloformates such as bischloroformate and mixtures prepared from the same components as claimed by applicants. Note applicant(s) "comprises" is open language and does not exclude those additional moieties etc. disclosed herein. Since the disclosed amounts or percentages are expressed differently and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious. In view of the above, there appears to be no significant difference

between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Claims 5-95 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0764676 see abstract, pages 2-7 and claims 1-10.

EP 0764676 discloses polycarbonate-polysiloxane block copolymers are prepared by interfacial polymerization technique in the presence of a phase transfer catalyst. Note on page 2 lines 45-56 the reaction mixture has two liquid phases which comprises a dihydric phenol, a polyalloxane diol, water, a water-immiscible, inert organic solvent for the block copolymer and a catalysts proportion of a phase transfer polymerization catalyst, which functions between the two phases. The process is followed by the step wherein carbonate precursor is introduced. The siloxane structures appear to be identical to those claims by applicants. Note pages 2-7.

With regard to claims 43-53 specifically, note that the claims are directed to the polycarbonate-polysiloxane copolymer itself is a product by process claim and does not appear to result in a structurally unique different polycarbonate-polysiloxane copolymer. Any properties or characteristics inherent in the prior art, e.g. haze value, T_g etc. , although unobserved or detected by the reference, would still anticipate the claimed invention. Note *In re Swinehart*, 169 USPQ 226. "It is elementary that the mere recitation of a newly discovered...property, inherently possessed by things in the prior art, does not cause claim drawn to those things to distinguish over the prior art".

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Thus, the reference discloses a polycarbonate- polysiloxane copolymer prepared from the same components as claimed by applicants. Note applicant(s) 'comprises' is open language and does not exclude those additional moieties etc. disclosed herein. Since the disclosed amounts or percentages are expressed differently and thus may be distinct from those claimed, it is incumbent upon applicant(s) to establish that they are in fact different and whether such difference is unobvious. In view of the above, there appears to be no significant difference between the reference(s) and that which is claimed by applicant(s). Any differences not specifically mentioned appear to be conventional. Consequently, the claimed invention cannot be deemed as novel and accordingly is unpatentable.

Correspondence

Please note that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. Applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Terressa Boykin whose telephone number is 571 272-1069. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. The general information number for listings of personnel is (571-272-1700).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tmb


Examiner Terressa Boykin
TERRESSA M. BOYKIN
PRIMARY EXAMINER